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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,543	11/29/2001	Helmut Scherzer	DE920000042	7268

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EXAMINER
SHRESTHA, BIJENDRA K

ART UNIT	PAPER NUMBER
3691	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/997,543	SCHERZER, HELMUT
	Examiner	Art Unit
	Bijendra K. Shrestha	3691

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-15_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 November 2001_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _07/16/2003_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Priority

1.   Acknowledgement is made of applicant's claim for priority to European Patent

Office (EPO) application 00127046.1 filed on 09/12/2000.

Drawings

2.   The drawings are objected to because description of labels 16, 18 and 20 are

overlapped in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The

figure or figure number of an amended drawing should not be labeled as "amended." If

a drawing figure is to be canceled, the appropriate figure must be removed from the

replacement sheet, and where necessary, the remaining figures must be renumbered

and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date

of an application must be labeled in the top margin as either "Replacement Sheet" or

"New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: change PU-ID, 18 (page 12, line 4). Corrected drawing sheets in

compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Curry

et al., U.S. Patent No. 5,949,880 (reference A in attached PT0-892).

6.   As per claim 11, Curry et al. teach a trading transaction device comprising:

means for entering a trading price, an input interface for a first mobile electronic

purse data carrier for performing monetary transactions (see Fig. 1; column 2, lines 38-

45; where microprocessor base device 104 is trading device),

the carrier comprising

a storage means for storing one or more payment units each having a respective monetary value, characterized by each of said payment units comprising an age information evaluable for delimiting the use of the payment unit (see Fig. 6; column 5, lines 63-67; column 6, lines 4-22, 25-30; where secure model 108 used by multiple service providers; the data objects stored in secure module include transaction count, encryption keys, money amounts, date/time stamps etc.) and

each of said payment units having a respective unique payment unit-ID (see Fig. 6; column 4, lines 7-10),

a connective interface to second such carrier (see Fig. 1; column 2, lines 45-68; where 106 forms a connective interface between portable module 102 and microprocessor based devices), and

means for updating the storage means of both carriers according to the transaction to be traded (see Fig. 6; where microprocessor based device updates monetary values and transaction counts as described in steps Y7 to Y13 in Fig. 5).

7.   As per claim 12, Curry et al. teach a method for managing electronic payments with an electronic purse data carrier, comprising the steps of:

checking for each transaction if age information of a payment unit being part of the transaction has exceeded a predetermined transaction age threshold level, and restricting the use of a payment unit with an exceeded transaction age threshold level (see Fig. 1; Fig. 4, step X6; column 7, lines 50-54; where transaction occurs only if transaction count (age information) matches).

8.   As per claim 13, Curry et al. teach claim 12 as described above.

Curry et al. further teach the method comprising the steps of:

using an age counter mechanism for checking the age information of a payment unit (see Fig. 4, step X1; Fig. 5, step Y1; transaction count (age information) is checked by transaction counter 206 in Fig. 2),

the counter mechanism being

implemented by encrypting a target number X, by successively applying, a total of m-times, a private key to a source key and the respective application result, said source key representing unused age information (see Fig. 4, step X1 and X2; column 7, lines 20-27),

said target number X being the result of applying, a total of n-times, a public key to said source key, on each payment transaction applying said public key on said age information yielding a respective current age data (see Fig. 4, step X4; column 7, lines 40-44), and

checking for each transaction if the age information of a payment unit being part of the transaction corresponds to the target number X (see Fig. 4, step X5 and X6).

9.   As per claim 14, Curry et al. teach claim 13 as described above.

Curry et al. further teach the method, in which

repetitive application of the public key to said source key, and the respective application results yields a monotone varying function with a transaction age threshold value corresponding to said target number X (see Fig. 4, steps X4-X6; where public key repetitively applied to source key (encrypted data packet) as transaction counter is

updated after each successful transaction; transaction is permitted if and only if counter

number matches).

10.   As per claim 15, Curry et al teach computer program product stored on a

computer usable medium comprising computer readable program means for causing a

computer to manage electronic payments with an electronic purse data carrier, where

the carrier stores age information corresponding to payment units stored thereon, the

computer program product causing the computer to perform the steps of:

        checking for each transaction if age information of a payment unit being part of

the transaction has exceeded a predetermined transaction age threshold level, and

restricting use of a payment unit with an exceeded transaction age threshold level (see

Fig. 3, steps X6 and X7; column 7, lines 50-54; Fig. 5; stepsY6 and Y7; column 8, lines

59-65; the secure model is programmed to check matching of its counter transaction

number with decrypted data's transaction counter number and transaction proceeds

forward if and only if they are exact match, to make sure that data received is not

counterfeit data).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-4 and 10 are rejected under 35 U.S.C. 103(a) as being anticipated by

Curry et al., U.S. Patent No. 5,949,880 (reference A in attached in PTO-892) in view of

Bellare et al. (reference AB in IDS submitted by the applicant).

13.   As per claim 1, Curry et al. teach an electronic purse data carrier for performing

monetary transactions, comprising

        a storage means for storing one or more payment units each having a respective

monetary value (see Fig. 2; Fig. 5, step Y12; column 3, lines 56-65; where monetary

data are stored in memory 202 of data carrier);

        each of said payment units comprising

        an age information for delimiting use of the payment unit (see Fig. 2; column 3,

lines 66-67; column 4, lines 1-4; where counter 206 in data carrier keep track of number

of transaction performed delimiting use of payment unit); and

        Curry et al. <u>do not teach that each of said payment units having a respective</u>

<u>unique payment unit-ID</u>.

        Bellare et al. teach that each of said payment units having a respective unique

payment unit-ID (see Fig. 1; column 2, lines 13-17; column 4, lines 1-3).

        Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include payment units having a respective unique

payment unit-ID of Curry et al. because Bellare et al. teaches that single use of fund

representation associated with a unique fund ID results indication in the database that

the fund representation may no longer be used (Bellare et al., column 2, lines 14-17).

14.   As per claim 2, Curry et al. in view of Bellare et al. teach claim 1 as described

above.

Curry et al. further teach the carrier, in which

said age information reflects the extent of transactional use of the respective

payment unit (see column 3, lines 66-67; column 4, lines 1-4).

15.   As per claim 3, Curry et al. in view of Bellare et al. teach claim 2 as described

above.

Curry et al. further teach the carrier, in which

said age information represents a date information (see Fig. 2; column 4, lines 2-

5; where timer 208 provide timestamp (date) information).

16.   As per claim 4, Curry et al. in view of Bellare et al. teach claim 3 as described

above.

Curry et al. further teach the carrier comprising

a processor for read and /or write access to said storage means, and means for

updating said age information whenever a transaction has been performed with a

respective payment unit (see Fig. 2; column 4, lines 4-6; where memory controller

(processor) 204 controls read and write access to memory 202 and updates transaction

counter and timer data to the memory).

17.   As per claim 10, Curry et al. teach a banking terminal device for accessing purse

data stored in a storage means of an electronic purse data carrier for performing

monetary transactions, the storage means storing one or more payment units each

having a respective monetary value (see Fig. 1; Automatic Teller machine, 112),

characterized by each of said payment units comprising

an age information evaluable for delimiting the use of the payment unit (see Fig.

4, step X1; where transaction counter count provides age information for delimiting the

use of the payment unit), and

the banking terminal device comprising:

implemented program means for verifying said age information (see Fig. 1;

column 3, lines 14-15; where microprocessor device verifies age information in the step

Y6 in Fig. 5), and

implemented program means for resetting said age information after successful

verification of said payment unit (see Fig. 5, step Y13; column 9, lines 11-12); and

Curry et al. do not teach each of said payment units having a respective unique

payment unit-ID.

Bellare et al. teach each of said payment units having a respective unique

payment unit-ID (see Fig. 1; column 2, lines 13-17; column 4, lines 1-3).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include payment units having a respective unique

payment unit-ID of Curry et al. because Bellare et al. teaches that single use of fund

representation associated with a unique fund ID results indication in the database that

the fund representation may no longer be used (Bellare et al., column 2, lines 14-17).

18.   Claims 5-9 are rejected under 35 U.S.C. 103(a) as being anticipated by Curry et

al., U.S. Patent No. 5,949,880 (reference A in attached PTO-892) in view of Bellare et al.

(reference AB in IDS submitted by the applicant) further in view of Teicher (reference

AA in IDS submitted by the applicant).

19.   As per claim 5, Curry et al. in view of Bellare et al. teach claim 4 as described

above.

Curry et al. further teach means for transferring a respective age information from

said parent unit to the plurality of child payment units, and means for generating a

resulting age information for said joined payment unit according to a predetermined rule

(see Fig. 5, steps Y10-Y13; column 9, lines 3-12; where age information is transferred

from ATM 112 to portable module (data carrier); Examiner interprets process is

transferring age information between card to card is essentially same as that from ATM

to cards as explained in Teicher reference below).

Curry et al. in view of Bellare et al. do not teach means for splitting a parent

payment unit having a given non-minimum parent monetary value into a plurality of child

payment units, each having a child monetary value smaller than the parent value, the

sum of child monetary values being the same as the parent monetary value, and means

for joining a plurality of single payment units having a given total monetary value into a

joined payment unit having a corresponding same monetary value.

Teicher teaches means for splitting a parent payment unit having a given non-

minimum parent monetary value into a plurality of child payment units, each having a

child monetary value smaller than the parent value, the sum of child monetary values

being the same as the parent monetary value, and means for joining a plurality of single

payment units having a given total monetary value into a joined payment unit having a

corresponding same monetary value (see column 26, lines 59-67; column 27, lines 1-

10; where card to card transaction feature allows transfer of electronic coins through

transaction device (essentially similar to purse-to-drawer interface) while maintaining

the integrity of the system).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to allow splitting a parent payment unit having a given non-

minimum parent monetary value into a plurality of child payment units of Curry et al. in

view of Bellare et al. because Teicher teaches that splitting a parent payment unit

having a given non-minimum parent monetary value into a plurality of child payment

units enable person-to-person transactions (Teicher, column 26, lines 61-63).

20.   As per claim 6, Curry et al. in view of Bellare et al. further in view of Teicher

teach claim 5 as described above.

Curry et al. in view of Bellare et al. do not teach means for generating a patching

pattern for splitting and/or joining payment units according to storage requirements

present on the carrier.

Teicher teaches means for generating a patching pattern for splitting and/or

joining payment units according to storage requirements present on the carrier (see

column 27, lines 1-9; where card-to-card transaction are limited according to the

electronic coins stored in both cards).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow means for generating a patching pattern for splitting and/or joining payment units according to storage requirements present on the carrier of Curry et al. in view of Bellare et al. because Teicher teaches that means for generating a patching pattern for splitting and/or joining payment units according to storage requirements present on the carrier would limit card-to-card payment according to the amount actually stored in both cards (Teicher, column 27, lines 4-6).

21.   As per claim 7, Curry et al. in view of Bellare et al. further in view of Teicher teach claim 5 as described above.

Curry et al. teach the carrier comprising

means for excluding a payment unit from an intended split or join process if said payment unit has exceeded a predetermined change threshold age level (Curry et al., Fig. 4, steps X6 and X7; column 7, lines 50-54).

22.   As per claim 8, Curry et al. in view of Bellare et al. further in view of Teicher teach claim 7 as described above.

Curry et al. in view of Bellare et al. do not teach a plurality of payment units of different monetary value.

Teicher teaches a plurality of payment units of different monetary value (see Fig. 26, column 2, lines 49-53).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow a plurality of payment units of different monetary value Curry et al. in view of Bellare et al. because Teicher teaches that allowing a

plurality of payment units of different monetary value would minimize storage

requirements for electronic coins and provide signal for security leak, if there is

forbidden repetition or out-of-range instances (Teicher, column 2, lines 55-65).

23.   As per claim 9, Curry et al. in view of Bellare et al. teach claim 1 as described

above.

Curry et al. in view of Bellare et al. <u>do not teach means for storing personal</u>

<u>identification Data associated with one or more payment units</u>.

Teicher teaches means for storing personal identification data associated with

one or more payment units (see column 27, lines 36-44).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to allow means for storing personal identification data

associated with one or more payment units of Curry et al. in view of Bellare et al.

because Teicher teaches that allowing means for storing personal identification Data

associated with one or more payment units would enable to identify unused electronic

bills upon the expiration date (Teicher, column 27, lines 51-51).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24.   Claim 1-5, 7 and 10-15 are rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over claims 1-15 of U.S. Patent No.

6,711,685. Although the conflicting claims are not identical, they are not patentably

distinct from each other because it involves counter allocated to secret pieces of

information (age information) and counter counts the number of uses of secret

information after matching the requirement and updates the counter after each use

(Schaal et al., abstract).

Conclusion

25.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosures. The following are pertinent to current invention, though not

relied upon:

        Collin (U.S. Patent No. 4,992,646) teaches transaction system of electronic purse

type.

        Jones et al. (U.S. Patent No. 5,440,634) teaches electronic purse value transfer

system.

        Hjelmvik (U.S. Patent No. 6,431,454) teach method of effecting payment with a

card that includes an electronic purse.

        Kawasaki-shi et al. (EP 1072997 A1) teach electronic purse system and

electronic purse unit.

Kingdon et al. (U.S. Patent No. 6,615,193) teach electronic value payment monitoring system and method.

Matsumoto et al. (U.S. Patent No. 6,345,263) teach electronic purse application system and method thereof.

Nakano et al. (U.S. Patent No. 5,987,438) teach electronic wallet system.

Rankl et al. (U.S. Patent No. 5,534,683) teach multifunctional card having an electronic purse.

Shiobara et al. (U.S. Patent No. 6,266,653) teach electronic money management.

Teicher (U.S. Patent No. 6,076,075) teach retail unit and payment unit for serving a customer with electronic wallet on purchase and method for executing the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on Monday - Friday, 7:30 a.m - 5 p.m, 2nd Friday OFF.
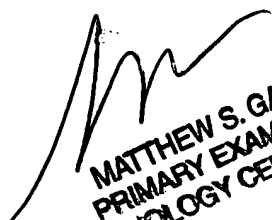
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571) 270-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BKS